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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/056,832

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Curtis A. Whitcomb

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BAKER & DANIELS LLP

300 NORTH MERIDIAN STREET

SUITE 2700

INDIANAPOLIS, IN 46204

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT

PAPER NUMBER

3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/056,832

Applicant(s)

WHITCOMB, CURTIS A.

Examiner

Dennis Ruhl

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 45 and 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 45 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's amendment of 9/1/06 has been entered. Currently claims 13,45, and 52 are pending.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 45 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 45 is directed to a system, which is taken to be the same as an apparatus type of claim. The statutory class of invention for claim 45 is apparatus and not a process or method claim. At lines 8-10 it is recited that "*the received product information being transferred as a replica order over the network to the replica manufacturer computing device*", and lines 13-15 recite "*the product information being transferred from the merchant computing device to the registrar computing device which generates the replica order*" and "*wherein the registrar computing device updates registration information in a database associating the product and the replica with an owner of the product*". Claim 45 includes recitations directed to the performing a step of transferring data in what is otherwise an apparatus type of claim. The language "being transferred" is a positive recitation of actually performing the recited step. This is improper and renders the claim non-statutory because this is a mixing of two distinct statutory classes of invention. The claim must be directed to either an apparatus or a method (process) and cannot be directed to both. *Ex parte Lyell* 17 USPQ2d 1548 (Bd. Pat. App. & Int 1990).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 45, it is not clear to one wishing to avoid infringement what the scope of the claim is and under what conditions infringement would occur. This problem stems from the fact that claim 45 is reciting method steps of actually using recited structure in an apparatus type of claim (i.e. "*the received product information being transferred as a replica order over the network to the replica manufacturer computing device*"). One wishing to avoid infringement would not know if just having the claimed system would infringe the system, or if having the claimed system and using it in the claimed manner would constitute infringement. This is not clear to one wishing to avoid infringement. A claim is considered to be indefinite when it attempts to recite both a system and a method of using that system. *IPXL Holdings, L.L.C. v Amazon.Com, Inc.* 430 F.3d 1377, 1384 (Fed. Circuit 2005)).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Borton Volvo Web page document (cited by the Board in the new grounds of rejection pursuant to 37 CFR 41.50(b)).

The examiner wants to make it clear on the record that the language of the claim that is directed to the performing of certain steps (see 101 and 112,2nd) has been considered but these method limitations have been given weight just to the extent that the prior art must be capable of doing what is claimed. The limitations have been considered as "functional language" due to the fact that the claim is an apparatus type of claim, not a method.

For claim 45, the document discloses that a customer can use their computer to order a replica of a Volvo 855. A customer who wishes to place an order can do so by using their computer to access the Internet (*the claimed network*) and can submit an order online. See the online ordering link disclosed on page 6 (as stated by the Board). As stated by the Board of Appeals in their decision (page 27), the name of the computing devices are not taken as reciting any functionality to the computing devices themselves. The *merchant computing device* is the customer computer. The claimed *registrar computing device* is considered to be the computer of the Borton Volvo Web page that stores the cited web page. When a customer wants to buy the replica of the Volvo 855, they can use their computer (merchant computer) to submit an order to the registrar computer (the Borton Volvo web page). When the order is placed this results in the product information (Volvo 855) being transferred from the merchant computer to

the registrar computer as claimed, so that the order can be processed by Borton Volvo. With respect to the *replica manufacturer computing device*, this is not taught in the cited reference. The examiner has interpreted this to be a computer at the replica manufacturer that manufactures the Volvo 855 model. The examiner notes that Borton Volvo does not advertise that they manufacture the parts they sell. They are not the manufacturer of the products they sell, just a parts dealer. It is old and well known in the art that product distributors like Borton Volvo will obtain the parts they sell from a parts manufacturer because they do not product the parts themselves, they just sell them. Borton teaches the online ordering of parts via the Internet. Because Borton does not make the Volvo 855 replica model, they must get it from a "replica manufacturer" at some point in time. To get the replica Volvo 855 in stock, they must order the replica from the replica manufacturer by submitting an order to the manufacturer in some manner. One of ordinary skill in the art would understand that Borton Volvo can submit the order to the replica manufacturer by phone, letter, or electronically by using the Internet. At the time of the filing of the instant application it was old and well known in the art that orders for products can be made over the Internet, Borton teaches this fact. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the manufacturer of the Volvo replica with a "*replica manufacturer computing device*" that is also connected to the Internet, so the replica manufacturer can take orders for the Volvo 855 electronically. This satisfies what is claimed as far the structure of the recited system goes.

7. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over The Fernwood Company, "Sweating the details.." article, (6/11/2000) in view of "Museum dreams are king-sized.....them back" (1998).

The article discloses that Fernwood is a company that makes replicas of buildings/landmarks for interested customers. It is disclosed that the Bangor Bank (the claimed merchant) asked Sandy Manship (an owner of Fernwood) to make replicas of homes newly sold to bank customers. The replica was then given to the purchaser of the home. The claimed term "purchase" is defined in the instant specification as generally meaning "an exchange of value" and includes the act of bestowing a product. The home purchaser being given the replica of their home satisfies the claim language of "purchase". Inherently the bank and Fernwood must *obtain product information relating to a visible feature* of the home. This can be interpreted as an employee of the bank taking a picture of the home so that Fernwood can be made aware of what the home looks like. To make the replica this information is necessarily required. *Information relating the owner of the product* is also obtained as claimed. This is information about whom it is that you are giving the replica to, i.e. the owner's name. The claimed information is communicated to Fernwood so they can *create the replica*. When the replica is given to the purchaser of the home it has been transferred as claimed.

Not disclosed is the creation of a certificate of ownership associating the replica with the owner. The Fernwood article discloses that their company is in competition with other companies that make similar custom miniatures, page 2. The article

discloses that "*To be successful, Fernwood of Maine has had to distinguish its product*", see page 2. The article also discusses the fact that the quality of the Fernwood replicas is better than some their competitors. The examiner points this out because Fernwood produces a unique product that has a quality that rivals or surpasses their competitors. The "Museum Dreams" article discloses that there are "Elvis Silver Anniversary" and "Elvis Gold 77 Ultimate Tribute" bourbon filled decanters that were issued certificates of ownership. This article teaches that it is know to associate a product with the owner by using a certificate of ownership, especially when that item is unique like the Elvis memorabilia. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the home purchasers with a certificate of ownership associating the replica with the owner as is commonly done with unique items as disclosed by the Museum Dreams article.

8. Claim 13 is allowed.

9. Applicant's arguments filed 9/1/06 have been fully considered but they are not persuasive.

With respect to claim 45, the examiner notes that the Board of Patent Appeals and Interferences rejected independent claim 33 and stated on page 27 that "We leave it to the examiner to consider whether similar rejections apply to the other claims in the application". The examiner has taken claim 45 into consideration and does not find it to be allowable.

With respect to claim 52, a new grounds of rejection has been set forth by the examiner because this claim is also viewed as not being allowable.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER



WYNNE W. COBURN
TECHNOLOGY CENTER DIRECTOR